

REMARKS

This Application has been carefully reviewed in light the Official Action mailed December 15, 1998. Claims 1-42 are pending. Claims 1, 4, 10, 11, 14, 20, 22, 25, 33, 36, 33 have been amended to further clarify the present invention. Applicant respectfully requests reconsideration and favorable action in this case.

I. § 112 REJECTION.

Claim 21 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Claim 20 has been amended to claim "a digital file". Thus, term "the digital file" in Claim 21, which depends from Claim 20, has proper antecedent basis and is in full compliance with 35 U.S.C. § 112, second paragraph.

II. DOUBLE PATENTING REJECTION.

The Examiner provisionally rejects Claims 1-4, 11-14, 22-25 and 33-36 under the judicially created doctrine of double patenting over Claims 1-4 and 11-15 of co-pending application 08/677,513.

Applicant will file a proper terminal disclosure necessary to overcome this rejection when the cases progress to issue. Of course, Applicant reserves the right to traverse this rejection if changes to the claims of either application moots the double patenting rejection.

III. THE PRESENT INVENTION IS NOT ANTICIPATED UNDER 35 U.S.C. § 102(e).

The Examiner rejects Claims 1-42 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,583,839 issued to *Ishida, et al.* ("*Ishida*"). Of these, Claims 1, 11, 22 and 33 are independent.

To anticipate a claim, the reference must teach each and every element of the claim. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2

U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Each and every element of the claimed invention must be literally present, arranged as in the claim. The identical invention must be shown in as complete an amount of detail as is contained in the patent claim. *Richardson v. Suzuki Motor Corp.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Under this standard, Claims 1-42 are not anticipated by *Ishida* and are in condition for allowance.

- A. *Ishida* Fails to Disclose, Teach or Suggest "the client operable to transmit data and video" when the data is "data associated with at least one financial transaction"

Nowhere in *Ishida* is there disclosed "a client operable to perform a financial transaction, the client further operable to generate data from the financial transaction, the client having a camera operable to generate video of the financial transaction, the client operable to transmit the data and video using a communications network." (Emphasis added, Claim 1, similar each Independent claim). The Examiner claims that the monitoring camera of *Ishida* can generate video associated with the financial transaction and that the ATM shown in FIGURE 19 and discussed at Column 5, line 55 can generate data associated with a financial transaction. However Claim 1, as amended, "a client operable to perform a financial transaction, the client further operable to generate data from the financial transaction, the client having a camera operable to generate video of the financial transaction requires". Thus, instead of data "associated with the financial transaction", the client needs to "generate data from the financial transaction". Thus, *Ishida* fails to disclose, teach or suggest all the limitations of Claim 1 (and, by the same argument, all of the independent Claims).

The Examiner is also wrong when he asserts *Ishida* shows the "client operable to transmit the data and video." To support this position, the Examiner points to Column 5, through Column 6, line 56 of *Ishida*. A careful reading of this section reveals that the Examiner's reliance is misplaced. That section details the physical layout of *Ishida's* system. And while an ATM is

discussed at Column 5, line 55, nowhere in the section cited to by the Examiner shows any connection between the ATM and the communications network or server. Thus, even if the ATM is considered generating financial data, it is physically impossible for that data to be transmitted over a communications network since the ATM machine is not connected to a communications network.

To further illustrate this point, Column 7, line 38 to Column 8, line 50 of *Ishida* is instructive. This section discusses what is transmitted over the communications network. The data discussed in this section is in no way related to any data generated by the ATM machine - the data the Examiner earlier claimed was the data associated with a financial transaction. Instead, as clearly indicated in the section pointed to by the Examiner, the data are control data signals. (See Column 7, line 42). This data is control data used to produce "control signals for operating the audio signal switch circuit 26 and video signal switch circuit 25" among other items. See Column 7, lines 63-65. Thus, no data associated with a financial transaction is stored in a digital file. Indeed, it is important to note that nowhere in the specification and nowhere in the figures is there discussed or illustrated a connection or cooperation between the ATM illustrated in FIGURE 19 and any part of the video conversation/monitoring system disclosed in *Ishida*. *Ishida* simply suggests that a functionally separate ATM may be co-located in a room with the video conferencing/monitoring system. Since the limitations of Claim 1 requires both "a client operable to perform a financial transaction" as well as a "client operable to generate data from the financial transaction" and then transmit that data, the Examiner must show somewhere in *Ishida* where the ATM machine, unconnected to any data line connection, is able to transmit data. Since that cannot be done, it is clear *Ishida* fails to disclose, teach, or suggest all of the limitations of independent Claims 1, 11, 22, and 33.

- B. *Ishida* Fails to Disclose, Teach or Suggest a Client Operable to "accumulate and store the data and video as a digital file"

An examination of FIGURE 3 and the accompanying textual explanation reveal that there are no facilities in the "client" of *Ishida* to store data and video. The Examiner, in the Office Action, claims that the storage of the digital file is the digital format communication. But storage in a digital file is a distinct limitation apart from transmission. Therefore, *Ishida* does not disclose, teach or suggest a client operable to store "the accumulated data and video as a digital file until the client connects to the server" as discussed in independent Claims 22 and 33.

The Examiner may point out that two patents mentioned in the specification, but not specifically incorporated by reference, namely U.S. patent No. 5,396,269 entitled Television Telephone and issued to Gotoh and U.S. Patent No. 5,790,178 drawn to a picture codec and issued to Shibata, discuss how video conferencing system work. But no where in these patents is it shown a client operable to store "the accumulated data and video as a digital file until the client connects to the server". The Examiner may very well point to Figure 11 of the '269 to refute this. But this figure merely shows how video signals, voice signals and data signals are multiplexed and temporarily stored in a buffer before communication. Again, storage is a distinct limitation apart from communication. Also, Figure 11 only works when a video phone is transmitting to a remote location; the buffer helps to control the data rate to the ISDN line. This temporary storage does not meet the limitation of "storing the accumulated data and video as a digital file until the client connects to the server". Nor are any data and video temporarily stored the same as the accumulated "generated data and video for multiple financial transactions" which is what stored in the digital file.

Also, since *Ishida* fails to show how any data from the financial transaction (ATM) is ever combined with any video of the financial transaction, *Ishida* fails to disclose teach or

suggest a "storing the accumulated data and video as a digital file".

- C. *Ishida* Fails to Disclose, Teach or Suggest a "server operable to receive the digital file upon connection from the client"

Since the client in *Ishida* produces no digital file, it is impossible for the server in *Ishida* to receive a digital file as disclosed in Independent Claims 22 and 33. Certainly there is no suggestion in *Ishida* to receive a digital file having video and data associated with a financial transaction. Again, there is never disclosed, taught, or suggested any interconnection between the ATM machine and the video conversation/monitoring system.

- D. Dependent Claims Rejected under *Ishida*

Claims 2, 12, 23, and 24 disclose a client comprising "a point-of-sales device and the financial transaction comprises the sale of an item." *Ishida* fails to disclose such a limitation. *Ishida* fails to show the location of its video conversation/monitoring device at a point-of-sale device. Indeed, *Ishida* indicates that his system is a "guidance system for local and public and governmental facilities" (Column 17, lines 58-59). Thus, while it may make sense to locate such a facility somewhere in a store to provide a customer with guidance information, it makes little sense, and *Ishida* fails to disclose, teach or suggest, to locate a guidance system at a point-of-sale device since an individual there is making a purchase, not seeking guidance.

Claims 3, 13, 24, and 35 disclose a client comprising "an automated teller machine and the financial transaction comprises a cash withdrawal." The Examiner points out that an ATM machine is discussed at Column 5, line 55 and Column 13, lines 65-67. While an ATM can be co-located with the video conversation/monitoring device, *Ishida* fails to disclose "the financial transaction comprising a cash withdrawal", the data

from which is stored in a digital file along with video associated with that financial transaction.

Claims 4, 14, 25, and 36 disclose a client comprising "a microphone operable to generate audio of the financial transaction, the client operable to transmit data, video and audio over the communications network." (Claim 4; similar language is in Claims 14, 25, and 36.) The Examiner claims that this limitation is shown in FIGURES 1 and 3. However, as discussed above, the data transmitted over the communications network is not the data associated with a financial transaction. Additionally, the microphone shown in FIGURES 1 and 3 is connected to the internal system and not the ATM. Therefore, then the audio generated is not audio generated from the financial transaction taking place at the ATM, but instead is some other audio which is generated in a different location.

Claims 5, 15, 26, and 37 disclose the server "forming a data window from the data and a video window from a video and overlays the data window on the video window." (Claim 5; similar language in Claims 15, 26, and 37.) This limitation is not found in *Ishida*. The Examiner points to Column 8, line 40-44 to support his contention that the limitation is shown. However, that section talks about overlaying certain text with a video in terms of a guidance message. This is not what Applicant's invention is doing. Data associated with a financial transaction is being overlaid with the video associated with a financial transaction. This is not the same as overlaying guidance information on a picture.

Claims 6, 16, 27, and 38 disclose a server operable to present "data from a plurality of financial transactions as a plurality of data windows presents videos from a plurality of video sources as a plurality of video windows, and associates the data windows with the corresponding video windows." (Claim 6; similar language is in Claims 16, 27, and 38.) The Examiner indicates that this limitation can be found in *Ishida*, Column 16, line 43 through Column 17, line 65. However, this section merely points out that the center station equipment in *Ishida* has multiple display screens and each display screen can display something different. One display screen displays a conversation

and monitors images in a main screen, the second monitor screen displays an image of a second conversation camera or drawing device, and a third monitor screen can be used for verifying communication information and system operation. This certainly is not the same as multiple video windows being formed on a screen with the data windows being associated with the video source video windows. Additionally, since the data in Claims 6, 16, 27, and 38 are associated with a financial transaction, and *Ishida* fails to show data associated with the identification of a financial transaction being transmitted across a communications network, it is impossible for the server to display such information in *Ishida*.

Claims 7 and 28 disclose a server operable to receive "user input to specify one of the data windows displayed, the video window associated with the specified data window." (Claim 7; similar language in Claim 28). This limitation is not shown in *Ishida*. The Examiner again points to the section which discusses how *Ishida* has multiple windows, but there is no discussion as to how choosing part of one window will display or cause to be displayed a second window associated with the first window. Again, since *Ishida* fails to show data from a financial transaction being transmitted across a communications network, *Ishida* absolutely cannot be displaying data associated with a financial transaction at the server.

Claims 8, 17, 29, and 39 disclose a server operable to "automatically switch as the video window to the video associated with the data in response to the presence or content of data." The Examiner points to Column 8, line 51 through Column 9, line 39 to show that *Ishida* shows such limitations. This section of *Ishida* merely discusses the operation of a video conversation between a person at a remote location and a person at the central station. It does not disclose automatically switching to a video window in response to the presence of data associated with that window. Any data discussed in this section is control data and not data associated with a financial transaction as discussed above.

Claims 9, 18, 30, and 40 disclose a server operable to display "the appropriate video window and data window upon

changes in one of the plurality of video windows." (Claim 30, similar language in Claims 9, 18 and 40) The Examiner points to Column 9, line 40 through Column 10, line 27 to show that *Ishida* discloses such a limitation. However, the Examiner's reading is misplaced. This section does not discuss data. This section does not discuss data associated with a financial transaction. And this section does not discuss displaying "the appropriate video window and data window upon changes in one of the plurality of video windows."

Claims 10, 20, and 31 disclose a client operable to store "accumulated data associated with a financial transaction and transmit the data when the client communicates with the server." *Ishida* points to Column 7, line 38 through Column 8, line 50 and Column 17, line 38-45 to show that *Ishida* includes this limitation. Once again, the Examiner's reading of *Ishida* is incorrect. Column 7, line 38 through Column 8, line 50 discusses how the various control channels and audio switching signals allow for audio and video to be sent from an end station to a central station. Note that the data discussed in this section is control data and not data associated with a financial transaction, as discussed earlier. Nothing in this section discusses accumulating data associated with a financial transaction.

Claims 19 and 41 disclose "receiving a user selection; and updating the video window and the data window in response to the selection." The Examiner indicates that this limitation can be found in *Ishida*, Column 5, line 31-51 and Column 15, lines 12-62. The Examiner is mistaken. *Ishida* does not discuss data associated with a financial transaction as disclosed in Applicant's present invention. Additionally, *Ishida* does not discuss a user being able to choose a selection and a video window being updated.

Claims 21, 32, and 42 disclose "a digital file that contains financial records accumulated since the last connection." Nowhere in *Ishida*, is it disclosed the accumulation "of financial records" in "a digital file" since "the last transaction." Indeed, there is no discussion of a digital file or accumulation

Indeed, there is no discussion of a digital file or accumulation of financial transactions in *Ishida*. Therefore, *Ishida* does not meet this limitation.

Conclusions

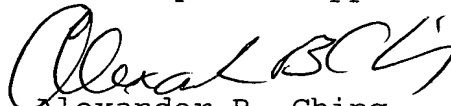
Applicant has now made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests reconsideration of all rejections and full allowance of all pending Claims. If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicant stands ready to conduct such a conference at the convenience of the Examiner.

An extension of one (1) month is requested and a Notification of Extension of Time under § 1.136 with the appropriate fee is attached hereto.

The Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker & Botts, L.L.P.

Respectfully submitted,

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